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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,292	09/23/1999	KENNETH LEE LEVY	LEVY/R	8259
7590	12/08/2004			
Kenneth AL. Levy 110 NE Cedar Street Stevenson, WA 98648			EXAMINER KIM, CHONG R	
			ART UNIT 2623	PAPER NUMBER

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/404,292	<b>Applicant(s)</b> LEVY, KENNETH LEE	
	<b>Examiner</b> Charles Kim	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25,26,29 and 32-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26,32 and 37-39 is/are allowed.
- 6) ☒ Claim(s) 25,33 and 40 is/are rejected.
- 7) ☐ Claim(s) 29,34-36 and 41-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment and Arguments*

1. Applicant's amendment filed on August 6, 2004 has been entered and made of record.
2. In view of applicant's amendment, the 112 first and second paragraph rejections are withdrawn.
3. Applicant's arguments, see pages 10-12, filed August 6, 2004, with respect to claims 25, 26, 33, 40 have been fully considered and are persuasive. The rejections of claims 25, 26, 29 and 32-51 have been withdrawn.

### *Claim Objections*

4. Claim 51 is objected to because of typographical errors. It appears that the applicant intended the limitation "(b)" in line 8 to read "(c)". Appropriate correction is required.

### *Double Patenting*

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 25, 33, 40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 09/810,080. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 25, 33, and 40 of the instant application cover equivalent subject matter and is merely a broader recitation of claim 14 in the copending application.

Claim 25 of the instant application recites, “retrieving the auxiliary information from the non-compressed form of the embedded data”, which corresponds to “detecting the first digital watermark in the media signal” in claim 14 of the copending application.

Claim 25 of the instant application recites, “compressing the non-compressed form of the embedded data”, which corresponds to “converting the media signal to a different format; wherein the new format is a compressed format of the medial signal” in claim 14 of the copending application.

Claim 25 of the instant application recites, “embedding the retrieved auxiliary information in the compressed embedded data, whereby the compressed embedded data comprises the auxiliary information embedded therein”, which corresponds to “embedding message information from the first digital watermark into a second digital watermark in the converted media signal such that the second digital watermark is adapted to robustness or perceptibility parameters associated with the new format” in claim 14 of the copending application. Note that the “message information” in claim 14 of the copending application is derived from the first digital watermark, and is therefore interpreted as the being analogous to the “auxiliary information” in claim 25 of the instant application.

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Claims 33 and 40 recite similar corresponding features to claim 14 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

7. Claims 26, 32, 37-39 are allowed.
8. Claims 29, 34-36, 41-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Koto et al., U.S. Patent Application Publication No. 2004/0117629 discloses a method for re-embedding a watermarked image after the watermarked image has been compressed (paragraph 85).

- b. Iwamura et al., U.S. Patent Application Publication No. 2004/0022412 discloses a method for re-embedding a watermarked image after the watermarked image has been compressed (paragraph 112).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ck

November 15, 2004

  
Jon Chang  
Primary Examiner